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Remarks/Arguments

Claims 1-14, and 22-28 are pending in this application. For at least the reasons stated below, Applicants believe that all claims are in condition for allowance as they are not obvious over the cited prior art.

The History of the Rejections

In the first office action the Examiner rejected the primary independent claim under 35 USC § 103(a) as unpatentable over Sheflott in view of Tibbetts and further in view of Flores. These same references were the basis of the 103(a) rejection in the second and third office actions by the Examiner. In response to Applicants' amendments and arguments the Examiner extended the 103(a) rejection in the fourth office action by stating that the claim was unpatentable over Sheflott in view of Tibbetts in view of Flores and in further view of Elance.com.

Applicants amended the independent claims and argued that a combination of the four references would not include all of the limitations in the claims. The Examiner has now issued the present office action, rejecting the independent claims with a chain of five references, namely, Sheflott in view of Tibbetts in view of Flores in view of elance.com and in further view of Ettl.

Stringing Together References is Not Enough for a Rejection

Applicants oppose the 103(a) rejection because it does not form a *prima facie* case of obviousness. In 1998, the Court of Appeals for the Federal Circuit reversed an Examiner's § 103 rejection that was issued by simply stringing together a series of prior art references, which the Court characterized as a "prior art mosaic." *In re Denis Rouffet, et al.*, No. 97-1492, 1998 WL 400169 (Fed. Cir.).

The Rouffet court was not surprised that the examiner was able to show a combination of references that contained all of the claim elements since "virtually all inventions are combinations of old elements." *Id.* If the Examiner only had to identify each claimed element in the prior art, then "very few patents would ever issue" since an Examiner could merely "use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention." *Id.* Using the claim as such a blueprint is an "illogical and inappropriate process by which to determine patentability." *Id.* (citing *Sensonics, Inc. v. Aerosonic Corp.*, 38 USPQ2d 1551, 1554 (Fed.

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Cir. 1996).

Earlier this year, the CAFC again addressed this issue. The CAFC held that an improper obviousness rejection might "break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious." *Richard Ruiz et al. v. A.B. Chance Co.*, No. 03-1333 (Fed. Cir., 2004). The "as of whole" requirement of § 103 prohibits such a form of "hindsight reasoning, using the invention as a roadmap [or blueprint] to find its prior art components" improper. *Id.*

In the present Application, the Examiner creates his § 103 obviousness rejection by breaking Applicants' invention into its component parts (A + B + C + D + E) and asserting five references to support the various components. Stringing together these five prior art references into a "prior art mosaic" is the same procedure that was overturned by the CAFC in both *Rouffet* and *Ruiz* and is therefore improper.

The Rationale for Combining the Five References is not Adequate

Finding prior art references to cover each of the limitations in the claims is just a first step of a 103 rejection. In *Rouffet*, the CAFC acknowledged that the Board did not err when it found that the combination of the references contained all of the elements of the claims in the application. The problem found by the CAFC was that there was not an adequate showing that one skilled in the art would have been motivated to combine those references.

The Examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*. In *Rouffet*, the Board did not explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely relied on the assertion that one skilled in the art would have a high level of skill and thus would recognize the ability to combine the references. The CAFC rejected this, stating that if "such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance." *Id.* Instead, the "Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection." *Id.*

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Applicants are faced with a similar rejection: the Examiner does not offer a legitimate rationale for the combination of the five references that are directed to five distinct problems. Reviewing the references one finds the following problems that were trying to be solved by each reference:

Reference	Problem to Solve	Support within Patent
Sheflott	Provides a system enabling quick, consistent and accurate response to a request for information , such as an RFP	Summary of the Invention (col. 3, lines 59-61)
Tibbetts	Provides a computer toolset to create objects to provide data and function mapping as an interface between the user interface (front-end) and the transactional back-end system (such as a database system).	Detailed Description of the Invention (col. 3, line 60 – col. 4, line 9). Note: the abstract uses the term "Proposal", which is given a specialized meaning in this patent and is not the type of proposal that an RFP from Sheflott
Flores	Provides a business with tools to manage its business processes by notifying the user that she has a task to complete, provide her with the tools and information to complete the task, allow her to see where the task fits in the overall process, and manage reminders to keep the process moving, etc.	Abstract
Elance.com	Provides an online marketplace for a small business to outsource projects (such as web development, graphic design, software, engineering, business strategy) to a pool of people providing such services .	http://www.elance.com/c/static/main/displayhtml.pl?file=about.html
Ettle	Provides an inventory	Summary of the Invention (col. 2,

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	management system that determines stocking levels for an inventory control mechanism	lines 58-65)
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The above table shows the vast differences among the five references. Especially noteworthy is Tibbetts. The Tibbetts invention is a data mapping technique between a computer interface and a back-end computer system. The Sheflott invention was concerned with a system for delivering RFPs. The problem of data mapping and the problem of responding to an RFP would not be something combined by one in the art. Ettle offers a solution to determining stocking levels for a store's inventory. One would not consider combining inventory calculation systems with a system that assists with providing answers for an RFP nor with a system that offers a solution to data mapping between a computer interface and a backend system. All five references are directed to solving five distinct problems and so the Examiner cannot "show reasons that the skilled artisan, confronted with the same problems" would combine the references", as required by *In re Rouffet*.

Investigating the office action, one finds little meaning to the Examiner's reasons to combine the references. First, the Examiner states that the motivation to combine Sheflott, Tibbetts and Flores is "to teach an architecture that takes advantage of the generic properties permitting it to be reusable for new types of transactions as enunciated by Tibbetts (col 1 lines 53-56)". As shown in the above table and discussed above, the problem solved by Tibbetts was a system for providing a toolset of items with "generic properties" for use in an architecture to provide data mapping between an interface and a backend system. The Examiner's statement suggests that Tibbetts can be reused for any new type of transactions. A careful reading of the reference shows that the reusability is solely limited to building new data mapping objects each time a developer needs to connect an interface with a backend system. The uses contemplated by the Applicants' invention is not something that Tibbetts can be reused for.

Then the Examiner asserts that it would have been obvious to one skilled in the art at the time of the invention to combine the first three references with Elance.com and Ettle to teach Applicant's invention because the "motivation to combine is to teach a system for analyzing and structuring business processes in a manufacturing production environment for monitoring inventory management in the presence of constrained capital budgets as enunciated by Ettl (col 2, lines 41-44)" (19 February 2004 Office Action, page 5). A system

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to monitor inventory and a system that provides a user with reminders and scheduling of business processes would not be combined. Furthermore these could not be combined to offer the type of system offered by the Applicants' invention. Here the inventor has simply used the key words of Elance.com ("analyzing and structuring business processes") with the key words of Ettl ("monitoring inventory management") and combined them in a single phrase even though a total reading of the references supports just how different the two inventions are.

In contrast to the above problems, Applicants' invention is directed to the problem of finding a service provider for manufacturing services, where the invention accepts a user's request, returns information on the service provider that best matches the request along with a hyperlink so that the user can access additional information about the service provider. Furthermore, the invention verifies budget constraints and as long as the budget isn't exceeded, allows the user to place an order for the manufacturing services.

To repeat again, by comparing the above table to the problem solved by the present invention, one can see that, for example, Tibbetts is directed to the very different problem of mapping data between a front-end and back-end computer system, and that Flores is directed to business project management rather than to a type of system for matching service providers to requests. A person skilled in the art searching for a solution to matching service providers to requests for manufacturing services would not consider combining the five references, especially since one reference is directed to using objects to map data from a computer front-end system to a computer back-end system, and another reference is directed to ensuring business processes are managed by notifying a user that she has a task to complete, providing her with the tools and information to complete the task, allowing her to see where the task fits in the overall process, and managing reminders to keep the process moving, etc.

The Examiner's has not shown reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed, as required by *Rouffet* since the five cited references are directed to five distinct problems. Therefore, the Examiner has failed to make his *prima facie* case of obviousness and the 35 USC § 103 rejections should therefore be withdrawn. Using the claim as a blueprint to chain together the five references in hindsight is an "illogical and inappropriate process by which to determine patentability." *Rouffet*.

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Since the rejections to the independent claims have been addressed, Applicants submit that all pending claims are in condition for allowance. Applicants respectfully request reconsideration of the claims and ask that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7508. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Attorney Docket # 060021-358401).

Respectfully submitted,



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